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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,200	02/04/2004	Pamela Jones-Morton	HON 1448-049	4236
8698	7590	09/18/2008	EXAMINER	
STANDLEY LAW GROUP LLP			PATS, JUSTIN	
495 METRO PLACE SOUTH				
SUITE 210			ART UNIT	PAPER NUMBER
DUBLIN, OH 43017			3623	
			MAIL DATE	DELIVERY MODE
			09/18/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/772,200	Applicant(s) JONES-MORTON ET AL.	
	Examiner JUSTIN M. PATS	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2-4-04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3-18-04</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Notice to Applicant

1. The following is a non-final, first office action responsive to applicant's communication of 2/4/04. Claims 1–19 are pending in this application and have been rejected below. Information Disclosure Statement (IDS), filed 3/18/04, has been considered.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1–19 are directed to non-statutory subject matter because they fail to meet the legal requirements of a 'process'. The first step in determining whether a claim recites patent eligible subject matter is to determine whether the claim falls within one of the four statutory categories of invention recited in 35 U.S.C. § 101: a process, machine, manufacture and composition of matter. The latter three categories define "things" or "products," while a "process" consists of a series of steps or acts to be performed. For the purposes of § 101, federal case precedent has given a "process" a specialized, and limited meaning. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876). A § 101 process must either (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process under § 101. Here, for example, claim 1 merely identifies, provides, administers, analyzes, adds, establishes, and matches data. These process steps are not tied to another statutory class, nor is there a transformation of the data pertinent to the claim. This logic also applies to claim 10 and its dependencies. Thus, the methods of claims 1–19 are not patent eligible processes under § 101.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1–2, 4–12, and 14–19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harvey, *The Selection of Managers for Foreign Assignments: A Planning Perspective*, The Columbia Journal of World Business, Winter 1996, pg. 102–12 in view of Mayer et al., U.S. Pat. Pub. No. 2001/0034630 [hereinafter Mayer].

6. As per claim 1, Harvey teaches a method for selecting expatriate associates comprising: identifying a plurality of associates who may be eligible for expatriate assignments (pg. 105, Exhibit 1, Dynamic Selection Process for International Personnel, Stage 2, Cluster Candidates); identifying a first set of candidates from said plurality of associates (*id.*, Pool of Potential Candidates); administering assessments to said first set of candidates (*id.*, Stage Three: Tactical Level, Selection of Candidates, Testing/Assessment); analyzing results for said assessments to identify a second set of candidates from said first set of candidates (pg. 111, “The focus of [Stage Three] is the assessment of individual candidates to identify those who have optimum personal skills and attributes to fulfill the requirements of the position. This phase will employ selection tools developed to identify qualified candidates.”); adding said second set of candidates to a group of candidates for said expatriate assignments (pg. 113, “Once the pool of

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'acceptable' candidates has been reduced, one additional dimension of the selection needs to be undertaken. Each candidate must be tested and assessed relative to additional skills that would increase the probability of success in his/her new international position. Two candidates may have equally attractive backgrounds/attributes for the assignment; but, to effectively manage in the future, what developmental activities will each candidate have to undertake before rising to another level of responsibility in the organization. The candidate who will need the least additional training might be preferred over the otherwise "equal" candidate.”); establishing a development plan for each candidate in said group of candidates (pg. 109, “More well-developed international human resource programs will have a defined succession plan for most managerial positions in the company's international operations.”; *see also* pg. 105, Exhibit 1, Dynamic Selection Process for International Personnel, Stage Three: Tactical Level, Selection of Candidates, Stage of Family Life-Cycle/ Career Cycle; pg. 112, discussing the importance of the family life-cycle in evaluating potential candidates for foreign assignment in terms of at least cost and adaptation; *see also* pg. 113, “Candidates must be evaluated on their enthusiasm or the intrinsic excitement of a new position overseas; but at the same time, the longrun relocation package and career benefits offered to the candidate must also be assessed.”); and matching at least one candidate from said group of candidates with an assignment from said expatriate assignments (pg. 105, Exhibit 1, Dynamic Selection Process for International Personnel, Stage Three: Tactical Level, Selection of Candidates, Selection).

Harvey does not explicitly teach providing each of said plurality of associates with information regarding said expatriate assignments, which they have reviewed prior to their identification as candidates. Mayer, in the analogous art of matching candidates to available job

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positions, teaches this functionality (Mayer, ¶¶0077–78, 0067).

It would have been obvious to one of ordinary skill in the art to modify Harvey to include the teaching of Mayer because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

7. As per claim 2, Harvey teaches creating an assignment plan for said at least one candidate (pg. 105, Exhibit 1, Dynamic Selection Process for International Personnel, Stage One: Policy level, Corporate Goals, Position Requirements/Criteria).

8. As per claim 4 neither Harvey nor Mayer teaches wherein providing each of said plurality of candidates with information regarding said expatriate assignments comprises providing each of said candidates with a realistic job preview video. However, Official Notice is taken that providing job preview videos was old and well known in the art of job recruiting at the time of the invention. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Harvey in view of Mayer to include the teaching of Official Notice for the benefit of providing the candidate with a more realistic and accurate depiction of the prospective position and therefore increasing the chances of procuring truly interested and committed candidates who will not drop out before completion of the assignment.

9. As per claim 5, neither Harvey nor Mayer explicitly teach wherein identifying a first set

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of candidates from said plurality of candidates comprises determining which candidates have decided to not proceed. However, Official Notice is taken that dropout candidates and their determination was old and well known in the art at the time of the invention. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Harvey in view of Mayer to include the teaching of Official Notice for the benefit of saving an organization money by preventing the overseas assignment of an unwilling or unmotivated person.

10. As per claim 6, Harvey teaches wherein said assessments comprise motivational (pg. 105, Exhibit 1, Dynamic Selection Process for International Personnel, Stage Three: Tactical Level, Selection of Candidates, Motivational Career Path), behavioral (*id.*, Interpersonal Skills, Stage of Family Life-Cycle/Career Cycle), cultural (*id.*, Cultural Adaptability/Flexibility), and technical (*id.*, Part Performance/Technical Competence, Leadership/Decision Making Style) assessments.

11. As per claim 7, Harvey does not explicitly teach wherein establishing development plans for each candidate in said second said set of candidates comprises establishing development plans according to gaps identified from said motivational, behavioral, cultural, and technical assessments. However, in stage 3 of its selection process (Exhibit 1, pg. 111–113), the method of Harvey determines these capability gaps identified from said motivational, behavioral, cultural, and technical assessments by weeding out unqualified or unable candidates that fall short of certain capabilities or characteristics. Furthermore, development plans for expatriate assignment candidates are old and well known as taught by Harvey as discussed above in the rejection of claim 1. Therefore, applying the known results of a gap analysis to a development

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plan would have been obvious to one of ordinary skill in the art to achieve a predictable result and result in an improved system that provides candidates with a better chance at improvement and success in the future by identifying the aspects of their capabilities that need the most improvement.

12. As per claim 8, Harvey teaches wherein at least one of said assessments is a self-assessment (pg. 112, discussing the administration of personality and psychological standardized tests to candidates to determine whether they are right for the position).

13. As per claim 9, Harvey teaches wherein analyzing results for said assessments to identify a second set of candidates from said first set of candidates comprises preparing a candidate selection summary report (Exhibits 4–5).

14. As per claim 10, the only difference between claim 1 and claim 10 is the reiteration of its method steps to produce additional, third and fourth sets of candidates. However, mere duplication of the parts of a method has no patentable significance unless new and unexpected result is produced. In re Harza, 124 USPQ 378 (CCPA 1960). Claim 1 is rejected above by Harvey in view of Mayer. Therefore, it would have been obvious to modify Harvey in view of Mayer to include this feature to produce a predictable result and result in an improved system that provides for a more rigorous selection process and thus improves the chances of picking the right person for the assignment.

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15. Claims 11, 12, 14, 15, 16, 17, and 18 recite limitations that stand rejected via the art citations and rationale applied to claims 1, 2, 9, 6, 8, 1, and 4 respectively as discussed above.

16. As per claim 19, Harvey in view of Mayer teaches the method of claim 10 wherein identifying a set of candidates comprises: providing each of a plurality of associates with information regarding an expatriate assignment (*see* discussion *supra* ¶ 6); and determining which associates have reviewed said information and withdrawn voluntarily from further consideration (*see* discussion *supra* ¶ 9).

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17. Claims 3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harvey in view of Mayer, as applied to claims 1–2 above, further in view of Poe, *Selection savvy: HR should invest in the selection process for expatriate assignments to prevent costly failures down the road - Global HR - human resources*, HR Magazine, April 2002, pg. 1–4.

18. As per claim 3, neither Harvey nor Mayer explicitly teaches completing arrangements to assign and relocate said at least one candidate for said assignment. Poe teaches this in the analogous art of expatriate selection processes (pg. 2, “In an effort to improve its success rate, Kellogg devised a pilot program intended to identify the best candidates for international assignments. The company asked managers to select possible candidates; then, HR and senior management reviewed the list and narrowed it down to 16 people. Those 16 people and their spouses were given assessment tests that looked at their work styles, values and interests. A comprehensive report on the findings was presented to the employees and their spouses, highlighting potential risks and areas of concern. To date, *four of the 16 candidates have been placed on assignment abroad*, and, Halvers on reports, “No negative issues have come up at all with these people.” (emphasis added)).

It would have been obvious to one of ordinary skill in the art to modify Harvey in view of Mayer to include the teaching of Poe because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

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19. Claim 13 recites limitations that stand rejected via the art citations and rationale applied to claim 3 as discussed above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUSTIN M. PATS whose telephone number is (571)270-1363. The examiner can normally be reached on Monday through Friday, 8:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on 571-272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Justin M Pats/
Examiner, Art Unit 3623

/Andre Boyce/
Primary Examiner, Art Unit 3623